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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,306	10/23/2001	Brian R. Dixon	5048PICID1	8710

7590

09/12/2003

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EXAMINER

MCKENZIE, THOMAS C

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 09/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/004,306

Applicant(s)

DIXON ET AL.

Examiner

Thomas McKenzie, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 6-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 8 and 9 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 7 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is in response to amendments filed on 8/8/03. Applicant has amended claims 1-3 and 8. Claims 1-3 and 6 are compound claims. Claim 7 is a composition claim. Claims 8 and 9 are use claims. This is the second action on the merits. The application concerns some 2-imino-1,3-oxazolidine compounds, compositions, and uses thereof.

Response to Amendment

2. Applicants' amendments have overcome all formal objections made in point #2-#4 of the previous office action. Applicants' amendment, clarifying that the substituent T must be substituted, overcomes the indefiniteness rejections made in point #5 and #6. Applicants' correction of a typo concerning variable G overcomes the indefiniteness rejection made in point #7. Applicants' deletion of the rejected disease treatments overcomes the enablement rejections made in points #8 and #9. Applicants' new provisos deleting specific compounds overcome the art rejections made in point #10-#12 but please see the new matter rejection made below.

Claim Objections

3. Claim 1 is objected to because of the following informalities: in proviso f) on page 9 of Applicants submission, the words "the" and "1,3-oxazol****" have become run together. Appropriate correction is required.

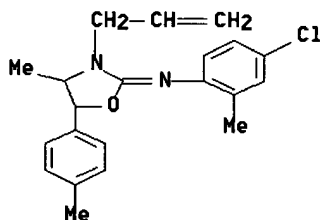
Claim Rejections - 35 USC § 112

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Claims 1-3 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The provisos g) in claims 1-3 lack description. Nowhere in the specification is the concept described that any specific compound embraced by the formula of claim 1, not be included in the formula. Such a negative limitation requires description. In *Ex parte Grasselli, et al.* 231 USPQ 393, decided June 30, 1983, the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences said: "we agree with the examiner's position of record that the negative limitations recited in the present claims, which did not appear in the specification as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C. 112." "It might be added that the express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded. This clearly illustrates that such negative limitations do, in fact, introduce new concepts."

Secondly, where are the required blaze marks pointing to these few excluded compounds in the forest of millions of compounds embraced by the formula of claim 1?

Claim Rejections - 35 USC § 102

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishimitsu (JP 63-41471 A2). There are three compounds in this reference that anticipate Applicants' compound claims. The compound shown below fits the formula of claim 1 with T = chlorine and methyl, t = 2, R = 2,4-substituted-phenyl, n = 2, R¹ = 2-propenyl, g = 0, R² = methyl, R³ = phenyl, q = 1, Q = methyl, p = 8, and X = oxygen. It has Registry Number 117518-55-5 and is found in the table on page 637 of the reference and is compound **53**. The other two compounds have R¹ = 2-propynyl and isopropyl. They are compounds **54** and **55**.



Allowable Subject Matter

6. Claims 7 and 8 are allowed. Claim 6 is objected to as being dependent upon a rejected base claim.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Applicant is reminded of MPEP §706.02, which requires art rejections, "be confined strictly to the best available art", and warns against making cumulative rejections. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this

action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Please direct any inquiry concerning this communication or earlier communications from the Examiner to Thomas C McKenzie, Ph. D. whose telephone number is (703) 308-9806. The FAX number for after final amendments is (703) 872-9307. The Examiner is available from 8:30 to 5:30, Monday through Friday. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Mukund Shah can be reached on (703) 308-4716. Please direct general inquiries or any inquiry relating to the status of this application to the receptionist whose telephone number is (703) 308-1235.

Mukund J. Shah

Mukund Shah
Supervisory Patent Examiner
Art Unit 1624

TCMcK

